UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/237,219	01/25/1999	DOUGLAS T. ROSENOFF	962.002US1	9491

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SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. BOX 2938
MINNEAPOLIS, MN 55402

EXAMINER
NGUYEN, MAIKHANH

ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/237,219	ROSENOFF ET AL.
	Examiner	Art Unit
	Maikhanh Nguyen	2176

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>02 April 2004</u>.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-9,14,15,17,19-49 and 64</u> is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>1-9,14,15,17,19-49 and 64</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date <u>8/10/03, 10/14/03 & 4/12/04</u>.
4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to communications: Response to Notice of Non-Compliance

filed 04/02/2004 to the application filed 01/25/1999; IDS filed 10/08/2003, 10/14/2003 and

04/12/2004.

2.   Claims 1-9, 14-15, 17, 19-49 and 64 are elected for examination. Claims 10-13, 16, 18,

and 50-63 have been cancelled. Claims 1-6, 14, 17, and 22-23 are independent claims.

Request Continuation for Examination

3.   A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection. Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)

has been timely paid, the finality of the previous Office action has been withdrawn pursuant to

37 CFR 1.114. Applicant's submission filed on 10/14/2003 has been entered.

Information Disclosure Statement

4.   The information disclosure statement filed 10/14/2003 fails to comply with 37 CFR

1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that

portion which caused it to be listed; and all other information or that portion which caused it to

be listed (e.g., copies of the Non Patent Literature references need to be submitted). It has been

placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

Claims 1-9, 14, 17, 19-26, 28, 31-38, 41-49 and 64 are rejected under 35 U.S.C. 103(a) as

being unpatentable over **Sotomayor** (U.S. 5,708,825 – filed 05/1995) in view of **Kanoh et al.**

(U.S. 5,873, 077 – filed 04/1996).

As to independent claim 17, Sotomayor teaches a method of automatically inserting

hyperlinks into a document *(Abstract)*, comprising:

- searching one or more documents *(e.g., scanning one or more documents…select*

source documents; Abstract);

- automatically marking one or more portions of one or more of the searched documents

based on results of searching the one or more documents *(e.g., automatically identifies*

significant key topics within the selected document; Abstract/ col.4, lines 24-30); and

- inserting one or more hyperlinks into one or more of the documents *(e.g., embeds*

hyperlinks from these summary pages to the locations where key topics appear in the

presentation pages; Abstract) with each hyperlink having a URL including a domain name

identifying a computerized service *(e.g., www.myserver.com; col.11, lines 9-18)* for use in

conducting a search based on the included portion.

Sotomayor does teach each hyperlink having a URL including a domain name identifying a computerized service, but is silent on "a URL including at least a portion of one of the marked portions."

Kanoh teaches each hyperlink having a URL including at least a portion of one of the marked portions *(col.5, lines 27-56 and col.8, lines 53-64)*.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the feature of Kanoh in the system of Sotomayor because Kanoh's teaching would have provided the enhanced capability for efficiently performing a search based on search terms on the searched documents.

As to independent claim 3, it is directed to a computer system for performing the method of claim 17, and is similarly rejected under the same rationale.

As to independent claim 4, it is directed to a computer system for performing the method of claim 17. However, claim 4 further recites "a processor" and "a memory".

Sotomayor teaches a processor *(web browser; col.5, lines531-67)* and a memory *(memory; col.5, line 64)*.

As to independent claim 1, the rejection of independent claim 17 above is incorporated herein in full. However, claim 1 further recites "receiving one or more documents."

Sotomayor teaches receiving one or more documents *(scanning one or more documents; Abstract)*.

As to independent claim 2, the rejection of independent claim 17 above is incorporated herein in full. However, claim 1 further recites "generating one or more hyperlinks."

Sotomayor teaches generating one or more hyperlinks *(automatically generated hyperlinks; Abstract)*.

As to independent claim 5, it is directed to a computer-readable medium for implementing the method of claim 17, and is similarly rejected under the same rationale.

As to independent claim 6, Sotomayor teaches an automated method of defining hyperlinks for a documents *(Abstract)*, comprising:

- automatically marking one or more portions of the documents *(automatically identifying significant key topics ... in the documents; Abstract)*; and

- defining one or more hyperlinks for one or more of the marked portions of the document *(e.g., embeds hyperlinks from these summary pages to the locations where key topics appear in the presentation pages; Abstract)*, with each hyperlink having a URL including a domain name identifying a computerized service *(e.g., www.myserver.com; col.11, lines 9-18)* for use in conducting a search based on the included portion.

Sotomayor does teach "each hyperlink having a URL including a domain name identifying a computerized service, but is silent on "a URL including at least a portion of one of the marked portions."

Kanoh teaches each hyperlink having a URL including at least a portion of one of the marked portions *(col.5, lines 27-56 and col.8, lines 53-64)*.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the feature of Kanoh in the system of Sotomayor because Kanoh's teaching would have provided the enhanced capability for efficiently performing a search based on search terms on the searched documents.

As to dependent claim 7, Sotomayor teaches each hyperlink further includes account information for a user *(www.myserver.com/user1; col.11, lines 9-18)*.

As to dependent claim 8, Sotomayor teaches each hyperlink includes a domain name common to all the hyperlinks *(www.myserver.com/user1; col.11, lines 9-18)*.

As to dependent claim 9, Sotomayor teaches each hyperlink includes a domain name common to all the hyperlinks and information based on a syntactic or semantic analysis of at east a portion of one of the marked portions of the document *(key-topic entries are key concepts and associated hyperlinks that were automatically generated from source documents... identify particularly high semantic weight key words; col.14, lines 52-59)*.

As to independent claim 14, the rejection of independent claim 6 above is incorporated herein in full. Additionally, Sotomayor further teaches associating the defined hyperlink with the marked portion of the first document *(e.g., embeds hyperlinks from these summary pages to the locations where key topics appear; abstract)*.

As to dependent claim 19, Sotomayor teaches the one or more predefined forms includes citations to printed publication *(At run time...The citation token, if chosen, will be replaced by the filename of the output document 64; col.28, lines 14-17)*.

As to dependent claim 20, Sotomayor teaches one or more of the marked portions includes a citation to a document, the citation including a volume identifier, a page identifier, and publication identifier, and wherein at least one of the generated hyperlinks includes volume, page, and publication identifiers *(automatically identifying significant key topics, concepts, and phrases in the documents; Abstract)*.

As to independent claim 21, the rejection of independent claim 17 above is incorporated herein in full. However, claim 23 further recites "one or more of the generated hyperlinks includes at least one query connector."

Kanoh teaches one or more of the generated hyperlinks includes at least one query connector *(col.8, lines 53-64).*

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the feature of Kanoh in the system of Sotomayor because Kanoh's teaching would have provided the capability for automatically creating a search query, and performing the search.

As to dependent claim 22, Sotomayor does not explicitly teach "one or more of the generated hyperlinks further includes at least one search instruction."

Kanoh teaches one or more of the generated hyperlinks further includes at least one search instruction *(col.10, lines 8-26).*

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the feature of Kanoh in the system of Sotomayor because Kanoh's teaching would have provided the capability for automatically creating a search query, and performing the search.

As to independent claim 23, the rejection of independent claim 17 above is incorporated herein in full. However, claim 23 further recites "one or more of the generated hyperlinks including a search-method identifer."

Kanoh teaches one or more of the generated hyperlinks further includes a search-method identifier *(the query created ... a http query 'e.g., a URL' an identifier of one or more characters; col.8, lines 53-64).*

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the feature of Kanoh in the system of Sotomayor because Kanoh's teaching would have provided the capability for automatically creating a search query, and performing the search.

As to dependent claim 24, Sotomayor does not explicitly teach "the search-method identifier identifies one of a natural-language search method and a Boolean search method".

Kanoh teaches the search-method identifier identifies one of a natural-language search method and a Boolean search method *(col.9, lines 38-50).*

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to include the feature from Kanoh in the system of Sotomayor because Kanoh's teaching would have provided the capability for identifying the search term locations, regardless of whether such documents are search forms.

As to dependent claim 25, Sotomayor teaches one or more of the hyperlinks further includes account information for a user *(www.myserver.com/user1; col.11, lines 9-18).*

As to dependent claim 26, Sotomayor teaches one or more of the generated hyperlinks further includes information identifying a third-party sponsor for facilitating access to a document in a database associated with the one hyperlink *(col.14, lines 31-51).*

As to dependent claim 31, Sotomayor teaches one of two or more destination is within the computer system and another of the two or more destinations is without the computer system *(hyperlink destinations; col.9, lines 11-45)*.

As to dependent claim 32, it includes the same limitations as in claim 20, and is similarly rejected under the same rationale.

As to dependent claim 33, note the discussion of claim 21 for rejection of "hyperlink include at least one query connector."

As to dependent claim 34, it includes the same limitations as in claim 22, and is similarly rejected under the same rationale.

As to dependent claims 35- 37, they include the same limitations as in claims 24-26, and are similarly rejected under the same rationale.

As to dependent claim 38, Sotomayor teaches associating the hyperlink with the marked portion includes associating the hyperlink with at least two marked portions *(col.3, line 63- col.4, line 8 and; col.4, lines 24-45)*.

As to dependent claim 41, Sotomayor teaches associating at least one of the generated hyperlinks with at least one of the marked portions includes anchoring at least one of the generated hyperlinks to at least one of the marked portions *(inserts identifying tokens for hyperlinks to those key topics; col.3, line 63- col.4, line 8/hyperlinks into the documents...to hyperlink through automatically generated hyperlinks; col.4, lines 24-45)*.

As to dependent claims 42-43, Sotomayor teaches searching the one or more documents comprises searching for citations to other documents *(At run time...The citation token, if chosen, will be replaced by the filename of the output document 64; col.28, lines 14-17)*.

As to dependent claim 44, Sotomayor teaches searching the one or more documents

comprises searching for proper names *(Abstract)*

As to dependent claims 45- 46, they include the limitations as in claims 32 and 21, and

are similarly rejected under the same rationale.

As to dependent claim 47, it includes the same limitations as in claim 35, and is

similarly rejected under the same rationale.

As to dependent claims 48-49, they include the same limitations as in claims 25-26, and

are similarly rejected under the same rationale.

As to dependent claim 64, it includes the same limitation as in claim 1, and is similarly

rejected under the same rationale. However, claim 64 further recites one or more legal citations.

Sotomayor teaches one or more legal citations *(Abstract/ col.4, lines 24-30).*

6.   Claims 15 and 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Sotomayor in view of **Kanoh et al.** as applied to claim 14 above, and further in view of **Rodkin**

et al. (U.S. 6,092,074 – filed 02/1998).

As to dependent claim 15, the combination of Sotomayor and Kanoh does not explicitly

teach "one or more user preferences includes information related to one or more preferred

hyperlink destinations, or information related to cost, or information related to access time; and

wherein defining the hyperlink includes selecting the one destination based on the retrieved

preferences."

Rodkin teaches one or more user preferences includes information related to one or more

preferred hyperlink destinations, or information related to cost, or information related to access

time; and wherein defining the hyperlink includes selecting the one destination based on the retrieved preferences *(Destination preferences 568 may influence the destination decision filter 565 so that preferred addresses are selected. For example, particular destination addresses may be assigned a preferred status upon payment of a fee, or based on other proprietary interest; col.13, line 65-col.14, line 2).*

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine Rodkin's teaching in the system of Sotomayor as modified by Kanoh because it would have provided the capability for allowing a Web developer to automatically enter hypertext links into a computer file such as a news article or other sequence of user-readable character strings.

As to dependent claim 29, the combination of Sotomayor and Kanoh does not explicitly teach "the one or more user preferences includes information related to cost; and wherein defining the hyperlinks including selecting the one destination based on cost."

Rodkin teaches the one or more user preferences includes information related to cost; and wherein defining the hyperlinks including selecting the one destination based on cost *(Destination preferences 568... destination addresses may be assigned a preferred status upon payment of a fee, or based on other proprietary interest; col.13, line 65-col.14, line 2).*

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine Rodkin's teaching in the system of Sotomayor as modified by Kanoh because it would have provided the capability for allowing a Web developer to automatically enter hypertext links into a computer file such as a news article or other sequence of user-readable character strings.

As to dependent claim 30, the combination of Sotomayor and Kanoh does not explicitly teach "the one or more user preferences includes information related to access time; and defining the hyperlinks including selecting the one destination based on access time."

Rodkin teaches the one or more user preferences includes information related to access time; and defining the hyperlinks including selecting the one destination based on access time *(The preference criteria may designate a particular type of web site... which the candidate destination addresses are obtained; col.12, lines 18-28).*

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine Rodkin's teaching in the system of Sotomayor as modified by Kanoh because it would have provided the capability for allowing a Web developer to automatically enter hypertext links into a computer file such as a news article or other sequence of user-readable character strings.

7.   Claims 27-28 and 39-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Sotomayor** in view of **Kanoh et al.** as applied to claims 1 and 17 above, and further in view of **Wolfe** (U.S. 6,263,351 – filed 02/1998, Continuation of application No. 09/014,669 – filed 01/1998), as cited by Applicant in IDS, filed 04/12/2004.

As to dependent claim 27, Sotomayor teaches inserting one or more hyperlinks *(e.g., embeds hyperlinks from these summary pages to the locations where key topics appear in the presentation pages; Abstract)*, but is silent on " changing font color associated with one of the marked portions."

Wolfe teaches changing font color associated with one of the marked portions *(a marker on ... highlighting can be done by changing the color ...which cases have been viewed; col.10, lines 15-34 and Fig.7D)*.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine Wolfe's teaching in the system of Sotomayor as modified by Kanoh because it would have provided the capability allowing the user to determine, by looking at each presentation, those which he or she has studied or already displayed. Such highlight provides a means by which user will know when he or she has looked at all the citing cases.

As to dependent claim 28, note the discussion of clam 27 above for the rejection.

As to dependent claim 39, it includes the same limitations as in claim 27, and is similarly rejected under the same rationale.

As to dependent claim 40, the combination of Sotomayor and Kanoh does not explicitly teach "changing the font associated with one of the marked portions comprises underscoring the one of the marked portions."

Wolfe teaches changing the font associated with one of the marked portions comprises underscoring the one of the marked portions *(col.10, lines 15-34 and Fig.7D)*.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine Wolfe's teaching in the system of Sotomayor as modified by Kanoh because it would have provided the capability allowing the user to determine, by looking at each presentation, those which he or she has studied or already displayed. Such highlight provides a means by which user will know when he or she has looked at all the citing cases.

Response to Arguments

8.   Applicants' arguments with respect to claims 1-9, 14-15, 17, and 19-49 have been considered but they are not persuasive.

Applicant argues that *applicant carefully studied this portion of Sotomayor ... cited passage does not teach one or more hyperlinks, with each hyperlink associated with at least one of the marked portions and each hyperlink having a URL that includes at least a portion of one of the marked portions.* "(Remarks, page 13)

In response, the Examiner believes that the introduction of Sotomayor, as combined with Kanoh meets the limitations as claimed by Applicant. Sotomayor teaches one or more hyperlinks, with each hyperlink associated with at least one of the marked portions *(e.g., embeds hyperlinks from these summary pages to the locations where key topics appear; abstract).* Kanoh teaches hyperlink having a URL that includes at least a portion of one of the marked portions *(col.5, lines 27-56 and col.8, lines 53-64).*

Conclusion

9.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Pitkow et al.   U.S Patent No. 6,457,028   issued: Sep. 24, 2002

10.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (703) 306-0092. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Joseph H Feild can be reached on (703) 305-9792.

The fax phone number for the organization where this application or proceeding is

assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Maikhanh Nguyen
June 9, 2004

JOSEPH FEILD
SUPERVISORY PATENT EXAMINER